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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK DUMONT and CHEE LAM TAN

Appeal 2008-0775
Application 09/748,947
Technology Center 2600

Decided: June 23, 2008

Before ROBERT E. NAPPI, MARC S. HOFF, and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 11-26. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

Appellants disclose a digital video recorder that uses a multiplexer for utilizing multiple video sources. (Spec. 1:3-5). The recorder also allows for

an input to be in a digital format and to record and/or monitor any of the sources. (Spec. 5:22-33).

Claims 11-26 are pending in the application. Independent claim 11 is illustrative:

> 11. A digital video recorder comprising:
>
> an encoder of a first analog signal into a first digital stream;
>
> a decoder of a second digital stream into a second analog signal;
>
> a medium interface for reading and recording on a medium;
>
> at least one digital source outputting a third digital stream; and,
>
> a multiplexer coupled to the encoder and to the decoder and to the digital source and to the medium interface,
>
> wherein the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Logan	US 5,371,551	Dec. 6, 1994
Hrusecky	US 6,317,164 B1	Nov. 13, 2001 (filed Jan. 28, 1999)
Rigatti	US 6,614,984 B2	Sep. 2, 2003 (filed Jan. 27, 1999)

The Examiner rejected claims 11-23, 25, and 26 under 35 U.S.C. § 103(a) as unpatentable over Logan and Hrusecky. The Examiner also

rejected claims 11, 17, 21, and 24 under 35 U.S.C. § 103(a) as unpatentable over Rigatti and Hrusecky[1].

We note that Appellants urge that each claim should be considered separately based on the arguments presented. (Br. 16). However, Appellants' arguments are all made on the same basis, with the only difference in the arguments recited in the separate sections that the subject matter of each claim is recited (Brief Sections I. B. through I. P. and II. B. through D.; Br. 21-34 and 37-40). We do not consider these to be separate arguments as 37 C.F.R. § 41.37(c)(1)(vii) states "a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." Accordingly, Appellants' arguments have grouped all of the claims in each rejection together, and we will concern ourselves the arguments directed to claim 11 under both rejections, as all of Appellants' traversals all rely on those arguments. (i.e., Brief Sections I. A. and II. A.; Br. 17-21 and 35-37).

Appellants argue that there is no motivation to combine Logan and Hrusecky or Rigatti and Hrusecky, and that the cited references fail to teach or suggest all of the elements of the independent claims. (Br. 17-21 and 35-37). The Examiner finds that coupling the decoder directly to the encoder or to a digital source (per Hrusecky) supplies all of the elements of the independent claims (Ans. 10-13), and that the motivation supplied to support the combinations of references is sufficient. (Ans. 9-10 and 13-14).

[1] We note, in passing, that the limitation "the second switch," in claim 15, lacks proper antecedent basis, but no rejection of claim 15 was made on that basis.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

I. Have Appellants shown that the Examiner erred in finding that Logan and Hrusecky teach or suggest all of the disputed elements recited in claims 11-23, 25, and 26?

II. Have Appellants shown that the Examiner erred in finding that Rigatti and Hrusecky teach or suggest all of the disputed elements recited in claims 11, 17, 21, and 24?

FINDINGS OF FACT

1. The application details a digital video recorder (DVR) system that takes inputs from digital and analog sources, where the analog signal is digitally encoded. The digital signals are multiplexed, where the digital signals can be sent to a medium interface for storage and/or sent to a digital decoder to be displayed on a display. (Spec. 3:27 – 4:33; Fig. 2, elements 12, 14, 16, 18, 20, 22, and 25).

2. Hrusecky discloses a system for creating multiple scaled videos from encoded video sources. The system includes video sources connected to a digital video decoder through a selecting switch that selects between those sources. The output of the decoder is coupled to both a display and a

frame buffer. (Col. 3, l. 64 – col. 4, l. 38; Fig. 1, elements 11, 12, 14, 25, and 27-29).

3. Logan discloses a time delayed digital video system using concurrent recording and playback. An input signal processing unit processes multiple types of inputs, where each input can be digital or analog, and can be compressed or uncompressed. The inputs are output of the unit as compressed digital signals and one is selected by a switching node. The selected signal is stored in the memory system, and thereafter can be sent to a display after being decompressed. The input and the output ports are interconnected to the memory and each other through a switch. (Col. 3, ll. 3-33 and 60-67; col. 4, ll. 14-25; Fig. 1, elements 3, 4A-4D, 5, 8, 10, and 12).

4. Rigatti discloses a universal storage device for different types of data. The device includes a memory that stores data received analog and digital inputs, which is also connected to a display. Data is sent out of the device through the output port, in either digital or analog form. (Col. 3, ll. 31-64; Fig. 5, elements 1, 5, 8, 11, 12, 15, and 17).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker,* 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997). "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the

prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.,* 127 S.Ct. 1727, 1734 (2007).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. "If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 1740.

ANALYSIS

Appellants argue that nothing in Logan or Hrusecky, or in Rigatti or Hrusecky, supplies motivation to combine either pair of references. (Br. 17-18 and 35-36). Appellants further argue that the references can only be combined if there is some suggestion or incentive in the prior art to do so. (Br. 18). The rejections, however, assert that a desire by skilled artisans to decode a plurality of digital video streams using a single decoder would lead to the combinations provided therein. We agree with the Examiner (Ans. 10 and 14) that the motivation supplied in each rejection is sufficient. While Appellants allege that improper hindsight reconstruction motivated the combination or that such motivation is improper if it only points to possible modifications, (Br. 18 and 35-36), the disclosure of Hrusecky illustrates that

the coupling of the decoder with the display is a predictable variation. *Id.* at 1739. As such, we find no error in the motivation to combine the references in either rejection.

Additionally, Appellants argue that even if there was motivation to support the combination, the combinations would fail to disclose all of the elements of the independent claims. (Br. 18-21 and 36-37). Appellants argue that Hrusecky fails to disclose an encoder, that neither Logan nor Rigatti nor Hrusecky discloses a multiplexer with multiple outputs, and that the combinations of Logan and Hrusecky or Rigatti and Hrusecky would not motivate one of ordinary skill in the art to develop a DVR having a multiplexer coupled to both a decoder and a medium interface, as required by the independent claims. (Br. 19 and 36-37). We do not agree.

As discussed above, the switching node in Logan is coupled to multiple parts of the video system. (FF 3). In Rigatti, the switch interconnects the input and output ports, as well as the memory. (FF 4). As acknowledged by both Appellants and the Examiner, neither Rigatti nor Logan discloses a digital stream being communicated from the encoder to the decoder without being recorded. However, Hrusecky does provide such a direct coupling of the selecting switch to the decoder, such that the video sources can be displayed on the display screen without being recorded in the frame buffer. (FF 2). Thus, Hrusecky provides a coupling that both Rigatti and Logan fail to disclose.

The independent claims do not recite that the multiplexers have a certain number of outputs, only that the multiplexer or the means for communicating are coupled to multiple elements in the DVR. While

Appellants argue that the combinations of Logan and Hrusecky or Rigatti and Hrusecky would not supply the couplings recited in the independent claims, Appellants, in effect, consider the combinations to have either one set of couplings, or the other, but not both. We find that it would have been logical for one of ordinary skill in the art to have added a coupling or connection to the switch or switching node, in either Logan or Rigatti, to supply the coupling suggested by Hrusecky. *Id.* at 1740. We also find that one of ordinary skill in the art would have viewed the combinations of references as suggesting that the digital input signals, and the encoded signals, be coupled to both the decoder and the memory systems, based on the motivations supplied in the rejections. As such, we find no error in the rejection of claims 11-23, 25, and 26 over Logan and Hrusecky or the rejection of claims 11, 17, 21, and 24 over Rigatti and Hrusecky.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 11-26, and we affirm the Examiner's rejection of those claims under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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